

REMARKS

The rejection of claims 1, 3-7 and 9-13 under 35 USC 103(a) as being unpatentable over Patent Publication No. US 2004-0084521A1 by Nagayoshi et al in view of Fukatsu (USP 4,524,268) and in view of Nomiyama et al (USP 6,779,728) is respectfully traversed.

Claim 1 is directed to a printed note deposit machine which includes the feature of a temporary money holder having a plurality of storage cells with predetermined storage cells assigned for separately segregating and storing counterfeit notes. The machine includes an identifying unit for classifying printed notes into categories of authenticated notes, counterfeit notes, unidentifiable notes and rejected notes.

Rejected notes, once identified as rejected notes, are accumulated in a rejection unit and are returned to the user, whereas counterfeit and unidentifiable notes remain captured in predetermined cells of the temporary money holder are not returned to the user. Instead, the counterfeit notes may be used, if necessary, as proof of the fact that they are counterfeit. This is one critical distinction between the subject invention and the prior art.

The Examiner has correctly recognized that the primary reference Nagayoshi does not disclose a temporary money holder nor does Nagayoshi teach assigning predetermined storage cells in a temporary holder for separately storing counterfeit notes. Instead, Nagayoshi simply rejects notes determined to be counterfeit (step 310) when it is deposited and unidentifiable notes are stored in a box (step 313) and unclassified notes are reexamined as shown in Fig. 4. Notes which are not genuine are

stored in a cash box with counterfeit notes (step 410) and are returned to the cash in/out unit for resubmission to the user. This is in sharp contrast to the subject invention in which counterfeit notes are segregated as counterfeit notes and placed in the temporary money holder and are never returned. Instead, they are used as proof that such notes are counterfeit.

The Examiner alleges that Fukatsu teaches a temporary money holder that stores unacceptable notes determined to be counterfeit via an identifying unit 20 for the purpose of restricting access to unacceptable notes. The Examiner further alleges that based upon this, it would be obvious to one skilled in the art to incorporate this feature into Nagayoshi to restrict access to counterfeit notes. However, Col. 5, lines 3-12 of Fukatsu clearly teaches that counterfeit notes temporarily held in the temporary holder 21 are then conveyed to the bill receiving/dispensing port 4 from which they are returned to the user and are not retained for use as proof that the notes are counterfeit. In fact, there is no teaching in Fukatsu to segregate and capture counterfeit notes and that Fukatsu does not contemplate restricting access to counterfeit notes but only to convey the counterfeit notes held in the temporary holder to the bill receiving/dispensing port 4. Moreover, in Fukatsu the group control section simply stores the remaining amount and replenishes the levels of each machine. There is no disclosure in Fukatsu to store machine serial number information of the machine when counterfeit notes and unidentifiable notes are found. Contrary to the allegation of the Examiner, Fukatsu does not segregate counterfeit notes and does not teach restriction access to such notes.

The Examiner also alleges that the reference Nomiya teaches a printed note deposit machine which comprises a predetermined storage cell 9 assigned to store

counterfeit notes which remain captured for further examination referring to Col. 5, lines 15-45.

However, in Nomiyama, there is no segregation of counterfeit notes and unidentified notes. Instead, the teaching in Nomiyama is to send the unidentified notes inclusive of counterfeit notes to the pay-out transaction which is contrary to the allegation of the Examiner that counterfeit notes are assigned to a particular storage cell and remain captured for further examination, such that counterfeit notes are not returned to the user. This is simply not taught in Nomiyama. Accordingly, even if Nomiyama were combined into Nagayoshi, unidentified notes inclusive of counterfeit notes would simply be sent to pay-out for return to the user.

For all of the above reasons, none of the cited references teach a machine as taught in claim 1, in which counterfeit notes are separately identified and segregated from other notes and upon examination are never returned to the user. Accordingly, claim 1 as amended is clearly patentable over the cited prior art taken individually or in combination.

Claims 3-7 are dependent claims which depend from claim 1 are believed patentable for the same reasons as given above.

Claim 9 has been amended in a fashion similar to that of claim 1 to clarify any misunderstanding regarding the captured counterfeit notes which are stored in the temporary money holder and never returned to the user. Instead, they are used as proof that such notes are counterfeit. Accordingly, claim 9, as amended, is believed to be patentable over the cited prior art for the same reasons as given above, relative to

claim 1.

The rejection of claim 8 under 35 USC 103(a) as being unpatentable over Nagayoshi in view of Fukatsu and in view of Nomiya as applied to claim 7 as well as USP 6,874,682 by Utz is respectfully traversed.

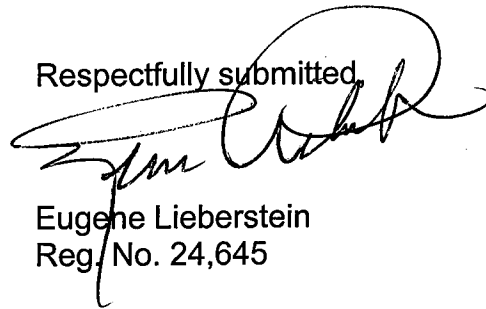
Claim 8 is a dependent claim which depends not only on claim 7 but on claim 1, as amended. Applicant wishes to point out to the Examiner that there is no disclosure in Utz to capture counterfeit and unidentifiable notes and to retain them and not return them to the user. The allegation that Utz teaches a data base apparatus installed in the central office for receiving transaction data from the memory of each of the plurality of printed note deposit machines so that transaction data is accumulated with the apparatus including a trace unit to match transaction data accumulated in the data base with transaction data relative to the notes is not a teaching for identifying counterfeit notes, segregating them from other notes in an assigned storage cell where it is retained and never returned to the user. There is no such teaching in Utz.

The Examiner's reference to Col. 23, lines 58-63 is being misinterpreted. There is no mention of the detection of counterfeit notes or its segregation from other notes and accordingly, there is no basis for the conclusion of the Examiner that using the configuration of Utz would modify the deposit machine of Nagayoshi/Fukatsu so that a user is notified of the existence of counterfeit notes. Moreover, there is no teaching in Utz to retain notes detected as "invalid" in a segregated cell never to be returned to the user.

For all of the above reasons, claims 1 and 3-13 are clearly patentable over the art of record.

Reconsideration and allowance of claims 1 and 3-13 is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Eugene Lieberstein', is written over the text 'Respectfully submitted,'.

Eugene Lieberstein
Reg. No. 24,645

Customer # 79681
BAKER & HOSTETLER LLP
45 Rockefeller Plaza
New York, NY 10111
Tel: 212-589-4634
Fax: 212-589-4201